



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/089,901	06/03/98	SHOJI	M YAMAP0575US

LM01/0404  
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EXAMINER

PSITOS, A

ART UNIT	PAPER NUMBER
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2752

DATE MAILED:

04/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/089,901

Applicant(s)  
Shoji et al

Examiner  
Psitos

Group Art Unit  
2752



☒ Responsive to communication(s) filed on Jun 3, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

2. Receipt is acknowledged of the IDS of Jan. 4, 1999. Applicants' attention is drawn to the dangers of partial translations - see Semiconductor Energy Lab. Co. V. Samsung Electronics Co. 46 USPQ2d 1874.

### *Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1,2,79, 11,12,17and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art JP 4-141827 further considered with Moriya et al.

The acknowledged prior art discloses a basic parameter testing/calibrating capability wherein the parameter selected is one of power which is equivalent to intensity.

The acknowledged prior art lacks any specific mention of a spiral track environment and that info. can be recorded on/in all areas.

Such a capability is well know as taught by Moriya et al.

It would have been obvious to one of ordinary skill in the art to modify the basic system of the above noted JP prior art system with the teaching from Moriya et al motivation being to use

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the above parameter setting ability with as many different types of records as possible, and hence increase the overall systems use.

The limitations of claim 2 are considered self evident.

For claims 7 and 17, intensity is interpreted as power.

The limitations of claims 9 and 19 are considered inherently present in Moriya et al and no further analysis is made.

5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1,2,11 and 12 above, and further in view of the acknowledged prior art

Applicants' have admitted that such a capability is well know in the art - see page 29 of the disclosure.

Whether one uses the above system with the acknowledged prior art is considered obvious to one of ordinary skill in the art, motivation being to take advantage of prior systems and hence increase the operability range (usage) of the parameter setting/calibrating technique.

6. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of Johann et al.

The ability of establishing an average of a parameter is considered to be well known as taught by the Johann et al reference.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability and further modify it with the 'averaging' capability of Johann et al - motivation being to obtain a better optimization parameter.

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7. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

Again, the limitations of claims 5 and 15 are acknowledged as being well known by applicant - see page 29 of the specification. Use thereof in the overall system is considered to be obvious to one of ordinary skill in the art - motivation being to perform the parameter calibration/optimization technique in an acknowledged system.

8. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 3 and 13 above, and further in view of the acknowledged prior art.

Applicants have acknowledged the prior art on page 29 of the specification referring to the ability to perform the optimization/calibration at separate times/locations. Hence the examiner interprets the claim limitation "are performed at two positions spaced apart" as having been met. Additionally, due to the spiral track layout of Moriya et al, the ability of having information on both the lands and the grooves inherently meets the above language as well.

9. Claims 8, 10, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Pietrzykoski et al.

The ability of having a plurality of parameters optimized is considered merely a duplication of effort as taught by Pietrzykoski et al which teach the optimization for a plurality of parameters in this environment.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability with the additional capability for doing so for

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a plurality of parameters as taught by Pietrzykoski et al - motivation being to perform such optimization techniques on as many parameters identifiable in the system that require correction and hence improve the overall system response.

Furthermore, Pietrzykoski et al discusses symmetry - see col. 10 line 8 plus as one of those parameters.

In the above rejections, the examiner notes that claims 11-20 are methods which parallel the apparatus limitations found in claims 1 -10. The examiner considers the method limitations to be met when the system is operational.

Applicants' attention is also drawn to the following references:

Pharris et al - system for optimizing system parameters, read/write time and focusing

Finkelstein et al - calibrating power in an optical system

Mashimo - intensity optimization in an optical system

Ito et al - optimization of recording/reproducing parameters in an optical system

Honda et al - averaging capability for optimizing power parameter in an optical system

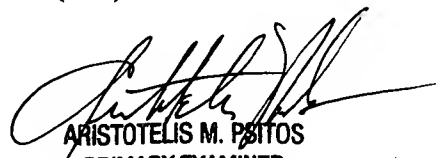
Lee et al - equalization optimization in an optical read channel

Ueki et al - optimization for servo control in an optical system

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (703) 308-1598.

amp

March 30, 2000

  
ARISTOTELIS M. PSITOS  
PRIMARY EXAMINER  
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